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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/613,646

07/02/2003

Burns Phillips

077119-0026

4622

1923

7590

12/05/2008

MCDERMOTT, WILL & EMERY LLP

Attn: IP Department

227 WEST MONROE STREET

SUITE 4400

CHICAGO, IL 60606-5096

EXAMINER

MERENE, JAN CHRISTOP L

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

12/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/613,646

**Applicant(s)**

PHILLIPS ET AL.

**Examiner**

JAN CHRISTOPHER MERENE

**Art Unit**

3733

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-24, 27, 28, 30-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-24, 27, 28, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 19, 30-31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 19 recites the limitation "upper and lower surfaces" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. The examiner assumes the applicant meant to disclose the limitations as discussed in Claim 18.
4. Claim 30 recites "a mount" in line 4 of the claim. There is insufficient preceding antecedent basis for that limitation.

***Allowable Subject Matter***

1. The indicated allowability of claims 17-24, 27-28 are withdrawn in view of the newly discovered reference(s) to Whitman. Rejections based on the newly cited reference(s) follow.
2. Claim 30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 17-19, 21-24, 27-28** are rejected under 35 U.S.C. 102(b) as being anticipated by Whitman US 3,789,835.

Regarding **Claim 17**, Whitman discloses a surgical retractor having at least one arm operably connected to a rack, the surgical retractor comprising: a clamp having an opening for receiving a portion of the arm, and a latch connected to the clamp for selectively retaining the clamp at a selected position on the arm; an angularly adjustable leg pivotally coupled to the clamp, the leg having a retractor blade connector head mount for receiving a connector head of a retractor blade; and an operator connected to the leg to adjust the angular position of the leg with respect to the clamp, the operator comprising a threaded shaft operably coupled to the clamp and the leg, wherein the threaded shaft is adapted for rotation to allow incremental movement of the leg relative to the clamp (see Fig below and see Col 2 lines 35-40, where the operator allows for increment movement of the leg).

Regarding **Claim 18**, Whitman discloses the opening comprises a slot defined by an upper surface and a lower surface (see Fig above and see Col 2 lines 30-33, where the opening defines a slot/track, which has an upper surface and lower surface).

Regarding **Claim 19**, Whitman discloses the latch is pivotally connected to the clamp adjacent one of the upper and lower surfaces (as seen in Fig above where the latch is adjacent to one of the upper and lower surfaces).

Regarding **Claim 21**, Whitman discloses a release button, the release button disengaging the latch to release the arm from the opening (see Fig above, where removal of the button will release the latch, where the arm can be released).

Regarding **Claim 22**, Whitman discloses wherein the leg extends cantileveredly away from the clamp (as seen in Fig above).

Regarding **Claim 23**, Whitman discloses the leg has a first projection and a second projection forming a U-shape (as seen in Fig above).

Regarding **Claim 24**, Whitman discloses the operator moves the leg relative to the clamp (see Fig below and see Col 2 lines 35-40, where the operator allows for increment movement of the leg).

Regarding **Claim 27**, Whitman discloses a quick release button to disengage the operator from the leg to rapidly change the angle of the leg relative to the clamp (as seen in Fig above, where the button can disengage the operator from the leg).

Regarding **Claim 28**, Whitman discloses the latch engages a tooth on the arm (as seen in Fig above, where the plain meaning of tooth is used [as a "projection resembling a tooth" as defined in Webster's Dictionary ISBN 0-395-33957-X], where the

arm extends from the rack, where a tooth projection extends from the arm, where the latch engages to).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. **Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitman US 3,789,385 in view of Santilli et al US 4,726,356.

Whitman discloses the claimed invention as discussed above but does not specifically disclose a spring biasing the latch to engage the arm into the opening.

However Santilli teaches that the use of a spring (see Col 5 lines 5-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Whitman to include a spring to bias the latch because springs are widely known in the art for their biasing characteristics when used in conjunction with a latch/knob (see Col 5 lines 5-10).

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 17-24, 26-28, 30-31 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

The prior art made of record and relied upon is considered pertinent to the applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAN CHRISTOPHER MERENE whose telephone number is (571)270-5032. The examiner can normally be reached on 8 am - 6pm Mon-Thurs, alt Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jan Christopher Merene/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733